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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/712,528	11/13/2003	Mitesh B. Sheth	M09713	8668

7590 12/14/2004

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EXAMINER

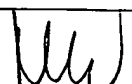
AVILA, STEPHEN P

ART UNIT PAPER NUMBER

3617

DATE MAILED: 12/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/712,528	Applicant(s) SHEETH, MITESH B.	
	Examiner Stephen Avila	Art Unit 3617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 October 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7, 9-14 and 16-20 is/are rejected.
- 7) ☒ Claim(s) 8 and 15 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-3, 7, 9, 10, 14, 16, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sumigawa in view of List et al. Sumigawa discloses the basic claimed structure including a marine propulsion system with a first containment 16 and a second containment 30 (oil sump; note column 1, lines 15-17, column 4, line 1) and cooling water (note the Abstract, for example). Not disclosed by Sumigawa is a polymer oil sump. List et al teach a polymer oil sump (column 2, lines 38-41). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to form the device of Sumigawa with a polymer oil sump as taught by List et al for light weight. Additionally, to form the drive shaft housing 16 to be of aluminum would have been an obvious choice of engineering design to a person of ordinary skill in the art at the time the invention was made for high strength and light weight.

3. Claims 4-6, 11-13, and 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sumigawa in view of List et al as applied to claims 1, 10, and 17 above, and further in view of Jones et al. Not disclosed by Sumigawa are the particular materials used. Jones et al teach an engine component of nylon reinforced with glass fibers (paragraph 0024). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to form the oil sump of Sumigawa of nylon reinforced with glass fibers as taught by Jones et al for high strength and light weight.

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4. Claims 8 and 15 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

5. Applicant's arguments filed October 25, 2004 have been fully considered but they are not persuasive.

Applicant alleges that a patent to Scheiterlein et al (not cited) does not disclose a plastic oil sump. However, it is noted that the rejections are based the List et al patent which teaches a plastic oil sump (column 2, lines 38-41).

Applicant further alleges that an "indirect" reference to a feature is not proper to be used in a rejection. However, the List patent clearly and directly sets forth the teaching of a plastic oil sump (column 2, lines 38-41).

Applicant further alleges that the Sumigawa, List et al and Jones et al teach away from Applicant's invention. However, to the contrary, the patents clearly teach in favor of the combination, as clearly set forth in paragraphs 2 and 3, above.

Applicant further alleges that in one embodiment the Sumigawa patent teaches that the exhaust pipe and the oil pan are formed as an integral structure. However, Applicant has not set forth where Sumigawa teaches that all of the embodiments teach that the oil pan and the exhaust pipe are formed as an integral structure. Additionally, it is not clear if the both the oil pan and the exhaust pipe in that embodiment are made of the same materials. They may just be directly attached to form an integral structure. Further, it is noted that the exhaust pipe and oil pan of List et al are of different materials.

Applicant further alleges that the List et al patent does not disclose nesting containers. However, the List et al patent is cited as teaching a plastic oil sump. The Sumigawa patent clearly discloses nested containers.

Applicant further alleges that the references do not suggest a benefit from the combination. However, the List et al patent clearly sets forth the benefit of noise reduction. Additionally, it is well known in the art that parts made of plastic can be formed of lighter weight than metal parts. Lighter parts can improve fuel mileage of the watercraft. A person of ordinary skill in the art would clearly find the combination to have been obvious based upon the above benefits.

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen Avila whose telephone number is 703-308-

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2578. The examiner can normally be reached on Monday to Thursday from 8 AM to 4 PM (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Samuel J. Morano can be reached on 703-308-0230. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Stephen Avila
Primary Examiner
Art Unit 3617

SA
12/10/04
